UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,291	10/31/2003	Martin T. Gerber	P-9492.00US	1410

27581 7590 03/12/2009

MEDTRONIC, INC.
710 MEDTRONIC PARKWAY NE
MINNEAPOLIS, MN 55432-9924

EXAMINER	
MANUEL, GEORGE C	

ART UNIT	PAPER NUMBER
3762	

MAIL DATE	DELIVERY MODE
03/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/698,291
Filing Date: October 31, 2003
Appellant(s): GERBER ET AL.

Jessica H. Kwak
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/19/08 appealing from the Office action mailed 6/23/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,255,695	FALWELL et al	8-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 8, 9, 11-15, 20, 21, 22, 24, 29, 32-36, 41, 42, 53, 55, 58, 59, 60 and 62 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Falwell et al (US 7,255,695).

Falwell et al disclose an embodiment in Fig. 14 that comprises a lead body having a proximal end 12 and a distal end 18. The examiner is interpreting 28B and 28C to comprise a plurality of stimulation electrodes and 28A to comprise a fixation mechanism. Col. 11, lines 63-63 teach the mapping and ablations sectors and/or wires may be activated independently, and may be activated concurrently.

Claims 2, 4, 5, 7, 10, 23, 25, 26, 28, 30, 31, 43-47, 52, 54, 56, 57, 61 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falwell et al (US 7,255,695).

Regarding claims 2, 4, 5, 23, 25, 26, 52, 54, 56, 57 and 61, one of ordinary skill in the art would have found it obvious to construct the wire-like elements of 28 with shape memory alloy, super-elastic material because Falwell et al suggest the braided conductive member 28 may be fabricated of a material of sufficient flexural strength so that the tissue is preferentially conformed to match the expanded or partially expanded shape of the braided conductive member 28. In addition, Falwell et al teach the filaments may be formed of Nitinol type wire.

Regarding claims 7, 10, 28, 31, 43 and 63, one of ordinary skill in the art would have found it obvious to construct the shaft portion 12 with a lumen to accommodate a stylet because a stylet is an art recognized actuating device and Falwell et al suggest a thumb wheel (or any other suitable actuating device) may be connected to one or more

pull wires which extend through shaft portion 12 and are connected to the distal end 18 of the catheter at an off-axis location.

Regarding claims 16-19, 37-40 and 48-51, one of ordinary skill in the art would have found it obvious to construct the fixation mechanism to have an expandable diameter in the range of approximately 2 to 15 mm because this diameter range represents a reasonable size for the use of the device disclosed in Falwell et al.

(10) Response to Argument

Falwell et al disclose a lead that includes both a plurality of stimulation electrodes and a fixation mechanism. Member 28A is not precluded from being a fixation member even if it is an electrode because it can be considered as not necessarily one of the plurality of electrodes.

The conductive member 28A permits fixation of the catheter 10 at a tissue site. Falwell et al teach, "[a]lternatively, braided conductive member 28 can be 'preformed' to a close approximation of that anatomy, and be of sufficient strength (as by choice of materials, configuration, etc.) to force the tissue to conform to variations found in specific patients." See col. 13, lines 57-61.

The limitations of claims 3, 8, 11, 24, 29, 32, 42, 55 and 62, are clearly met by the disclosure and teachings set forth in Falwell et al.

The teachings that apply to the function of the sheath 26 and the restrained-expansion member 28 are applicable to the embodiments shown in the disclosure of Falwell et al.

When the sheath 26 is removed from restraining the member 28, the conductive member 28 is allowed to expand. In addition, the distal joint, the portion where the distal end of the wire-like element meets the lead body, is weaker than the proximal joint as the sheath is removed. The distal end becomes exposed and lacks the support provided by the sheath in relation to the proximal joint. See Figs. 4 and 5.

The portion of the lead body comprising member 28 is elastic and the diameter of the lead body comprising member 28 is inversely proportional to the lead length comprising member 28. This is shown in Figs. 4 and 5.

In the broadest, reasonable interpretation, a stylet is a probe and elements 12 and 18 provide an axial force to restrain the wire-like elements against expansion under the sheath 26.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/George Manuel/
Primary Examiner, Art Unit 3762
Conferees:

/Angela D Sykes/

Supervisory Patent Examiner, Art Unit 3762

/Michael W. Phillips/

RQAS